



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,530	12/05/2001	Naoto Akimoto	1232-4792	1342

27123 7590 06/09/2006
MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2625

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/006,530	Applicant(s) AKIMOTO ET AL.	
	Examiner Beniyam Menberu	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see Remarks, filed May 8, 2006, with respect to rejections of claims 1, 6, 18 under U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0051181 A1 to Nishimura and claims 10, 17, and 19 under U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0051181 A1 to Nishimura further in view of U.S. Patent No. 6658456 to Shimoosawa have been fully considered and are persuasive. The rejection of claims 1-19 has been withdrawn.

2. Applicant's arguments, see Remarks, filed May 8, 2006, with respect to the rejection(s) of claim(s) rejections of claims 1, 6, 18 under U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0051181 A1 to Nishimura and claims 10, 17, and 19 U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0051181 A1 to Nishimura further in view of U.S. Patent No. 6658456 to Shimoosawa have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al.

Priority

3. Receipt of translation of Japanese Patent Application No. 2000-399017 and Japanese Patent Application No. 2000-377047 has been acknowledged.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 8, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al further in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al.

Regarding claims 1, 16, and 18, Miller, Jr. et al disclose a communication apparatus/method/program (Figure 1, reference 18, 12) comprising: reception means for receiving data (Figure 1, reference 18; column 5, lines 38-41); conversion means for converting the received data into electronic mail (Figure 2, reference 36; column 4, lines 56-65); and transmission means for transmitting the electronic mail converted by said conversion means to be forwarded to a plurality of destinations (column 5, lines 54-67; column 6, lines 1-8). However Miller, Jr. does not disclose receiving color image information.

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64).

Miller, Jr. et al are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color image transmission of Blair et al with the system of Miller, Jr. et al to implement color image forwarding through e-mail.

The motivation to combine the reference is clear because if a receiver is capable of printing color images then it would be convenient for the receiver to receive color images through e-mail.

Regarding claim 2, Miller, Jr. et al in view of Blair et al teach all the limitations of claim 1. Further Miller, Jr. et al disclose the communication apparatus according to claim 1, wherein said conversion means attaches an image received by said reception means to the electronic mail (column 5, lines 63-67).

Regarding claim 8, Miller, Jr. et al in view of Blair et al teach all the limitations of claim 1. Further Miller, Jr. et al disclose the communication apparatus according to claim 1, wherein said reception means receives said image based on a facsimile procedure (column 5, lines 35-41).

6. Claims 3, 4, 5, 10, 12, 13, 14, 15, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa.

Regarding claim 3, Miller, Jr. et al in view of Blair et al teach all the limitations of claim 1. However Miller, Jr. et al in view of Blair et al does not disclose the communication apparatus according to claim 1 further comprising: registration means for registering the plurality of destinations for said transmission means to transmit said electronic mail.

Shimoosawa disclose the communication apparatus further comprising: registration means for registering the plurality of destinations for said transmission means to transmit said electronic mail (Figure 4, reference 52; column 4, lines 66-67; column 5, lines 1-11).

Miller, Jr. et al, Blair et al, and Shimoosawa are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the registration system of Shimoosawa with the system of Miller, Jr. et al in view of Blair et al to implement registration of email address for forwarding data.

The motivation to combine the reference is clear because by registering email address will make forwarding of received data quicker.

Regarding claim 4, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 1. Further Miller, Jr. et al in view of Blair et al further in view of Shimoosawa discloses the communication apparatus according to claim 3, wherein said conversion means attaches the image received by said reception means to the electronic mail (Miller, Jr. et al: column 5, lines 63-67), and said

registration means has a method of attaching said image registered for each destination (Shimoosawa: Figure 4, reference 53; column 5, lines 13-29).

Regarding claim 5, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 4. Further Miller, Jr. et al in view of Blair et al further in view of Shimoosawa discloses the communication apparatus according to claim 4, wherein said method of attaching also includes information on whether or not to attach said image to the electronic mail (Shimoosawa: column 5, lines 13-20).

Regarding claims 10, 17, and 19, Miller, Jr. et al disclose a communication apparatus/method/program (Figure 1, reference 18, 12) comprising:
reception means for receiving data (Figure 1, reference 18; column 5, lines 38-41);
management means for managing a forwarding destination (Figure 2, reference 34; column 4, lines 43-56);
transmission means for transmitting the data received by said reception means as electronic mail (Figure 2, reference 38; column 4, lines 61-65). However Miller, Jr. et al does not disclose management means for managing setting on forwarding of received data for each mail address of the data received by said reception means; and transmitting the data as electronic mail based on information managed by said management means and receiving color image information.

Shimoosawa disclose management means for managing setting on forwarding of received data for each mail address of the data received by said reception means (Figure 4, reference 53; column 5, lines 13-29); and

transmitting the data as electronic mail based on information managed by said management means (Figure 3, reference 44; column 6, lines 25-37).

Blair et al disclose receiving color image information (column 15, lines 25-35; column 18, lines 56-67).

Miller, Jr. et al, Blair et al, and Shimoosawa are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the management setting of Shimoosawa and the color image reception system of Blair et al with the system of Miller, Jr. et al to implement management of data forwarding.

The motivation to combine the reference is clear because managing the setting can help forward received data quicker and efficient and if the destination terminal has color reception capability it would be convenient to be able to forward color image received from a source terminal.

Regarding claim 12, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 10. Further Shimoosawa discloses the communication apparatus according to claim 10, wherein said management means manages whether to transmit only the text (column 8, lines 50-61), transmit only the attachment file (column 10, lines 55-67) or transmit both the text and the attachment file of said received data (column 9, lines 62-67; column 10, lines 1-16).

Regarding claim 13, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 10. Further Miller, Jr. et al disclose the

communication apparatus according to claim 10, wherein said management means is capable of managing a plurality of said forwarding destinations for each address (column 5, lines 53-67).

Regarding claim 14, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 10. Further Shimoosawa disclose the communication apparatus according to claim 10, wherein said management means manages whether or not the forwarding destination is a mobile terminal (Shimoosawa discloses that mobile PDA can be used as recipient of email data (column 1, lines 24-29; column 8, lines 48-55; column 9, lines 1-13)).

Regarding claim 15, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 14. Further Shimoosawa disclose the communication apparatus according to claim 14, wherein said management means manages the setting in the case of forwarding to the mobile terminal (Shimoosawa teaches that when transferring data to mobiles like PDA, the attachments can be excluded from the data sent to prevent the PDAs from becoming memory full (column 8, lines 48-67)).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa further in view of U.S. Patent No. 6721783 to Blossman et al.

Regarding claim 6, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 4. However Miller, Jr. et al Blair et al

Art Unit: 2625

further in view of Shimoosawa does not disclose the communication apparatus according to claim 4, wherein said method of attaching includes information on whether to attach all or a part of said received image.

Blossman et al disclose the communication apparatus, wherein said method of attaching includes information on whether to attach all or a part of said received image (Blossman et al disclose method of sending bank customers images of bank related documents through email based on customer preference on which documents to be sent (column 16, lines 1-5, lines 23-33, lines 45-54).).

Miller, Jr. et al, Blair et al, Shimoosawa, and Blossman et al are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the selective email transmission system of Blossman et al with the system of Miller, Jr. et al in view of Blair et al, further in view of Shimoosawa to implement destination specific transmission of image data.

The motivation to combine the reference is clear because the teaching of Blossman et al can implement a destination specific transmission of important documents based on preference of users (column 4, lines 38-41).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa further in view of U.S. Patent No. 6266160 to Saito et al.

Regarding claim 7, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teach all the limitations of claim 4. However Miller, Jr. et al in view of Blair et al further in view of Shimoosawa does not disclose the communication apparatus according to claim 4, wherein said method of attaching includes information on an encoding system of said attached image.

Saito et al disclose the communication apparatus according to claim 4, wherein said method of attaching includes information on an encoding system of said attached image (Figure 3, "Supported Data Format"; column 3, lines 17-24, lines 65-67; column 4, lines 1-6).

Miller, Jr. et al, Blair et al, Shimoosawa, and Saito et al are combinable because they are in the similar problem area of email forwarding of received data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the encoding specification of Saito et al with the system of Miller, Jr. et al in view of Blair et al further in view of Shimoosawa to implement destination specific encoding of image data.

The motivation to combine the reference is clear because Saito et al teaches that the data format depends on capability of receiving side thus there is a need to include information on encoding (column 4, lines 1-6).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 9, Miller, Jr. et al in view of Blair et al teaches all the limitations of claim 8. However Miller, Jr. et al in view of Blair et al does not disclose the communication apparatus according to claim 8, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Miller, Jr. et al, Blair et al, and Fujii et al are combinable because they are in the similar problem area of email transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ITU-T T.37 standards of Fujii et al with the system of Miller, Jr. et al in view of Blair et al.

The motivation to combine the reference is clear because Fujii et al teaches that image transmission through email is done using ITU-T T.37 standard (column 1, lines 20-23).

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 11, Miller, Jr. et al in view of Blair et al further in view of Shimoosawa teaches all the limitations of claim 10. However Miller, Jr. et al in view of Blair et al further in view of Shimoosawa does not disclose the communication

Art Unit: 2625

apparatus according to claim 10, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Miller, Jr. et al, Blair et al, Shimoosawa, and Fujii et al are combinable because they are in the similar problem area of email transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ITU-T T.37 standards of Fujii et al with the system of Miller, Jr. et al in view of Blair et al further in view of Shimoosawa.

The motivation to combine the reference is clear because Fujii et al teaches that image transmission through email is done using ITU-T T.37 standard (column 1, lines 20-23).

Other Prior Art Cited

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6882446 to Tohyama et al disclose data communication apparatus.

U.S. Patent No. 5461488 to Witek discloses a fax system.

U.S. Patent Application Publication Pub. No. US 2003/0046241 A1 to Toshikage et al disclose image transferring system.

U.S. Patent No. 6424425 to Otsuka discloses facsimile with reading mode.

U.S. Patent Application Publication Pub. No. US 2002/0051223 A1 to Izumi et al disclose image communication device.

U.S. Patent No. 6519049 to Nagasaka discloses a system for transferring print data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2625

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

05/26/2006

K Williams

KIMBERLY M. WILLIAMS
SUPERVISORY PATENT EXAMINER